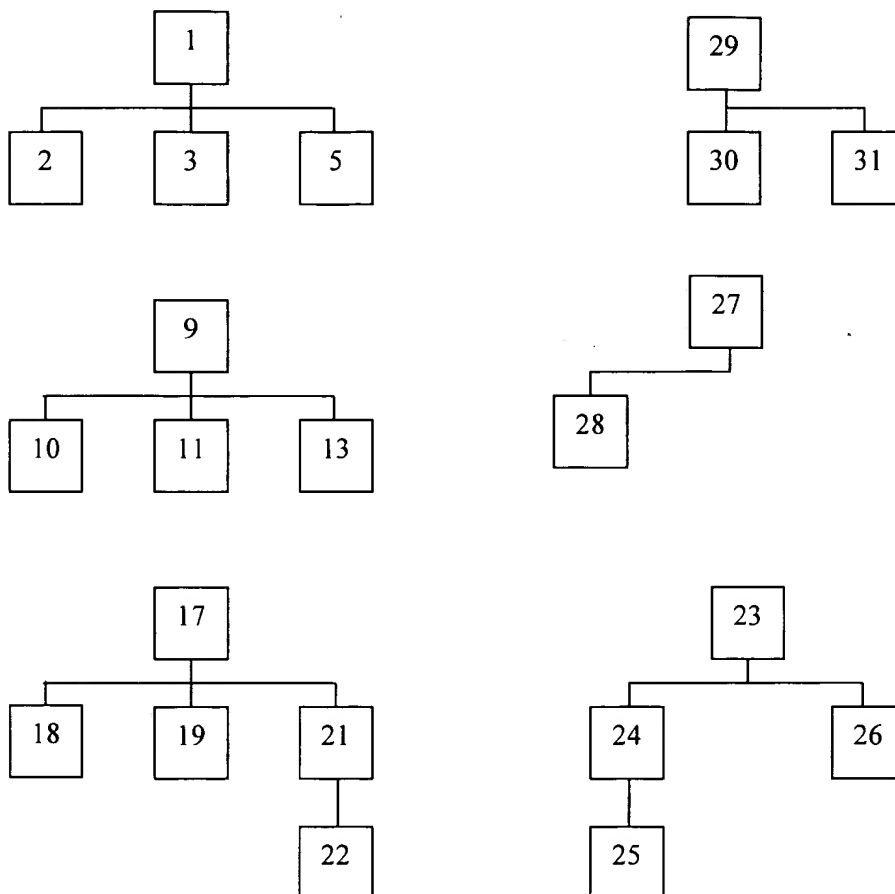


### REMARKS

Original claims 1-34 have been examined. Below is a claim diagram illustrating the relationship among the claims remaining after entry of this amendment.



Claims 1-22, and 26-28 are rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

All of the claims have been rejected as unpatentable over the prior art of record. Specifically, claims 1-5, 9-11, 14, 23, and 28 are rejected as anticipated by U.S. Patent No. 5,706,457 to Dwyer et al. (herein "Dwyer"), and claims 6, 12, and 15 are rejected as obvious over Dwyer. Claims 7, 8, 13, and 16 are rejected as being obvious over Dwyer in view of U.S. Patent No. 5,937,160 to Davis et al. (herein "Davis"). Claims 17-20 are rejected as obvious over Dwyer in view of U.S. Patent No. 5,796,393 to MacNaughton et al. (herein "MacNaughton"). Claims 21, 22, and 28<sup>1</sup> are rejected as being obvious over Dwyer in view of MacNaughton, and further in view of U.S. Patent No. 5,809,145 to Slik et al. (herein "Slik"). Claims 24-27 and 29-32 are rejected as being obvious over Dwyer in view of Slik. Finally, claims 33 and 34 are rejected as being obvious over Dwyer in view of Slik, and further in view of Davis.

**Section 112 rejection, Second Paragraph—Claims 1-22 and 26-28**

Claims 1-22 and 26-28 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In response, Applicants amend claims 1, 9, 17, 22, and 26-28 to overcome the minor informalities identified by the Office action. Additionally, housekeeping amendments have been made to claims 3, 5, 11, 13, 19, 21, 23-25, and 29-31. In addition, claims 4, 6-8, 12, 14-16, 20, and 32-34 have been canceled, rendering moot their Section 112 rejections.

**Section 102 rejection—Claims 1-5, 9-11, 14, 23, and 28**

In an effort to expedite prosecution, independent claims 1, 9, 17, 23, 27, and 29 have been amended to clarify the features of the present invention. In addition, because dependent claims 4 and 14 are canceled, the rejection relating to these claims is not addressed herein.

Dwyer does not, among other things, disclose the images being automatically stored in different storage devices as recited in amended independent claims 1, 9, 17, 23, 27, and 29. Instead, Dwyer stores all of the images in the same device, namely the hard

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<sup>1</sup> It appears that the rejection of claim 28 under Section 103 is an error, because the Office action did not specifically discuss claim 28 as it relates to the Section 103 rejection. Applicants assume herein that claim 28 is rejected only under Section 102.

drive of the computer that is transferring the images (Dwyer, Col. 8, lines 47-49).

The invention allows users to designate several alternative destinations for an image and then initiate an automatic transfer of the image to the selected destination – e.g., a printer, a CD-write device, a web site, and an email recipient. The transfer is accomplished without necessarily saving the transferred images to the hard drive of the computer (Applicants' specification, page 6, lines 26-27). As a result, the invention may be used on a computer that, for example, has no hard drive or minimum hard drive capacity (Applicants' specification, page 6, lines 27-28). In another embodiment of the present invention, although the images are saved to the hard drive of the computer in response to a user selecting one of the multiple available destinations, the images appear to the user to be transferred directly from the image device to the selected destination (Applicants' specification, page 5, lines 24-27).

In contrast in Dwyer, the images are saved to an “album,” which is a file on the hard drive of the computer (e.g., a single storage device). Only through further user interaction can the images be transferred to other destinations (Dwyer, Col. 2, lines 13-30). As a result, contrary to the assertions of the Office action, Dwyer does not disclose automatically transferring images to a destination selected from several alternatives, where the alternative destinations are different storage devices as recited in the independent claims.

The remaining claims 2-5, 10-11, and 28 depend from independent claims 1, 9, and 27, respectively, and they are patentable for at least the reasons set forth above with regard to their corresponding independent claims. Nevertheless, Applicants reserve the right to present further arguments in the future with regard to the dependent claims in the event that the independent claims are found to be unpatentable.

#### **Section 103 Rejection— Claims 6-8, 12, 13, 15-22, 24-27, and 29-34**

Claims 6-8, 12, 15-16, 20, and 32-34 have been canceled. As for the Section 103 rejection of independent claims 17, 27, and 29, Dwyer does not, among other things, disclose or suggest (1) automatically transferring images to a selected storage site via a browser vices as recited in independent claim 17 and (2) automatically transferring

images to a selected destination from multiple destinations, where the possible destinations are alternative storage devices as recited the independent claims 27 and 29.

The remaining dependent claims 13, 18, 19, 21, 22, 24-26, 30, and 31 are patentable over the references of record for at least the same reasons as those given above with respect to their independent claims 9, 17, 23, and 29. Applicants reserve the right to present further arguments in the future with regard to the dependent claims in the event that the independent claims are found to be unpatentable.

### CONCLUSION

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Grace Law, Reg. No. 48,872  
One of the Attorneys for Applicants  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

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